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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,452	12/31/2001	Ronald L. Edens	17,725	9483

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KIMBERLY-CLARK WORLDWIDE, INC.
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EXAMINER

REICHLE, KARIN M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 11/18/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/039,452

Applicant(s)

EDENS ET AL.

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 7,10-17,24 and 27-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,9,18-23,25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-8,10,12.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of the species of Figure 17 in Paper No. 11 is acknowledged. The traversal is on the ground(s) that the field of search would be coextensive. This is not found persuasive because the field of search would not be coextensive for all five species. Furthermore search and consideration of the prior art with regard to the five species would be burdensome.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 7, 10-17, 24, 27-51 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 11.

In addition to claims 7, 14, 17, 24, 27, 31, 34, 41, 44, 48 and 51 which were deemed not to read on the elected species as discussed in the telephone interview of 10-08-03, claims 10-13, 15-16, 28-30, 32-33, 35-40, 42-43, 45-47 and 49-50 do not read on the elected species because Figure 17 does not show a continuous point of juncture, folding along the transverse axis and the cover forming at least a portion of at least the lower surface of the article.

Description

3. The disclosure is objected to because of the following informalities: on page 1, line 3, "claims priority from" should be --claims the benefit of--^A. On page 2, lines 16 and 18, reference to the inventors should be avoided. On page 6, line 15, after "z-axis", --Z-Z-- should be inserted.

Appropriate correction is required.

4. The use of the trademark KOTEX(R)(page 11, lines 6 and 22 and page 12, line 6) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Trademarks should be shown either in all capital letters or with a trademark symbol but not both.

Claim Objections

5. Claims 1-6, 8-9, 18-23 and 25-26 are objected to because of the following informalities: in claims 1 and 18, line 2, "the"(last) should be --a--. Also on the second to last line and last line, respectively, "a finger" should be --the finger--. In claims 2 and 12, line 2, "a principal" should be --the principal--. In claims 3 and 20, "absorbent article further comprises" should be --principle axis comprises one of--. In regard to claims 4 and 21, second to last line, after "of", insert --said--. Appropriate correction is required.

Claim Language Interpretation

6. It is noted that while "labial pad" is defined on page 5, lines 10-13 that the claims are drawn to an "absorbent article". "Vestibule", "disposition of the absorbent article into the

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vestibule”, and the various directional terms used in the claims are interpreted as defined on page 5, lines 14-17 and 27-29, page 5, lines 21-23, and page 6, lines 5-20, respectively.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Rosenbluth ‘208.

With regard to claim 1, see Figures, i.e. the absorbent article is 10 and comprises an absorbent 22 or 80, see col. 5, lines 1-6, the absorbent article is configured for disposition within the vestibule, see, e.g. the abstract, first sentence and Figure 5, and has a lower surface which is adaptable to define a finger receiving area, see element 32 or 74, of dimensions sufficient to at least temporarily receive at least a portion of a finger in a manner that allows at least the portion of the finger to be positioned substantially parallel to a principal axis of the article, see, e.g. Figure 22. It should be noted that in claim 1, the axis could be either the longitudinal, transverse or z-axis.

9. Claims 1 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolby-Falk ‘813.

With regard to claims 1, and 18, see Figures, i.e. the absorbent article is 1 and comprises an absorbent 6, a liquid impermeable lower surface 4, and a liquid permeable upper surface 5, see col. 4, line 57-col. 5, line 33, the absorbent article is configured for disposition within the vestibule, see, e.g. col. 1, lines 12-17 and col. 4, lines 47-56, and the lower surface is adaptable to define a finger receiving area, see element 7, of dimensions sufficient to at least temporarily receive at least a portion of a finger in a manner that allows at least the portion of the finger to be positioned substantially parallel to a principal axis of the article, see, e.g. Figure 4. It should be noted that in claim 1, the axis could be either the longitudinal or transverse axis.

10. Claims 1-3, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Osborn PCT '610.

With regard to claims 1, 3, 18 and 20, see Figures 1-4, i.e. the absorbent article is 20 and comprises an absorbent 44, a liquid impermeable lower surface 38, and a liquid permeable upper surface 42, see page 7, second full paragraph, the absorbent article is configured for disposition within the vestibule, see, e.g. page 6, line 2-page 7, line 5, and the lower surface is adaptable to define a finger receiving area, see element 52 and page 17, last three paragraphs, especially page 17, last sentence, of dimensions sufficient to at least temporarily receive at least a portion of a finger in a manner that allows at least the portion of the finger to be positioned substantially parallel to a principal axis of the article, see, e.g. Figure 4 which shows the finger substantially parallel to the z-axis. It should be noted that in claim 1, the axis could be the longitudinal, transverse or z-axis. Note also claims 2, 3, 19 and 20. It is further noted with respect to claims 2-3 and 19-20 that the principal axis claimed in these claims and those in claims 1 and 18 do not have to be the same. With regard to claims 2-3 and 19-20, see Figure 4 and page 18, first full

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paragraph, i.e. a recess is formed by folding the article along the principle longitudinal axis with identical halves on each side thereof.

11. Claims 1-6, 8-9, 18-23 and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Lassen et al '062.

With regard to claims, see Claim Interpretation Section *supra*, see Figures 1-12, i.e. the absorbent article is 30 and comprises an absorbent 74, a liquid impermeable lower surface 70, and a liquid permeable upper surface 80, see col. 18, line 8-col. 19, line 38, a principal longitudinal axis along which the article is folded, see Figures, especially Figure 11 and col. 12, lines 1-26, discrete points of juncture in the center and end regions, see especially Figure 3 and col. 6, lines 46-53 and col. 12, lines 27-66 (Note the specific dimensions of each region with respect to the overall article have not been set forth) and a recess, below and adjacent points 72, see especially Figures 8 and 9. The absorbent article 30 is configured for disposition within the vestibule, see col. 1, lines 18-22, col. 6, lines 17-20, col. 9, lines 20-59 and col. 11, lines 14-35. Claims 1, 4, 18 and 21 set forth the lower surface being adaptable to define a finger receiving area of dimensions sufficient to at least temporarily receive at least a portion of a finger in a manner that allows at least the portion of the finger to be positioned substantially parallel to a principal axis of the article, specifically the distal portion of the finger and the principal longitudinal axis, i.e. properties, functions and capabilities of the lower surface. See the portions of Lassen et al cited *supra*, i.e. Lassen includes all the claimed structure. Therefore there is sufficient factual evidence for one to conclude that the properties, capabilities and function of such claimed structure are also inherent in the same structure of Lassen. See MPEP 2112.01. It should be noted that in claim 1, the axis could be the longitudinal, transverse or z-axis. Note also

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claims 2, 3, 19 and 20. It is further noted with respect to claims 2-3 and 19-20 that the principal axis claimed in these claims and those in claims 1 and 18 do not have to be the same.

12. Claims 1-6, 8-9, 18-23 and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al '392.

With regard to claims, see Claim Interpretation Section *supra*, see Figures 1-3, i.e. the absorbent article is 1 and comprises an absorbent 6, a liquid impermeable lower surface 6, and a liquid permeable upper surface 70, see col. 2, lines 31-36, a principal longitudinal axis 2 along which the article is folded, see Figure 2, and col. 2, lines 36-41, discrete points of juncture 4 in the center and end regions, see also col. 2, lines 44-48 (Note the specific dimensions of each region with respect to the overall article have not been set forth) and a recess, between points 4, see especially Figures 2-3. The absorbent article 1 is configured for disposition within the vestibule, see col. 1, lines 1-3 and 33-34. The lower surface is adaptable to define a finger receiving area, see col. 2, lines 9-19, of dimensions sufficient to at least temporarily receive at least a portion of a finger in a manner that allows at least the portion of the finger to be positioned substantially parallel to a principal axis of the article, see, e.g. Figure 3 which shows the longitudinal axis of the finger substantially parallel to the z-axis. It should be noted that in claim 1, the axis could be the longitudinal, transverse or z-axis. Note also claims 2, 3, 19 and 20. It is further noted with respect to claims 2-3 and 19-20 that the principal axis claimed in these claims and those in claims 1 and 18 do not have to be the same. In regard to claims 4 and 21, it should be noted that the claim does not require the longitudinal axis of the distal portion of the finger being parallel to the principal longitudinal axis, i.e. the transverse axis of the distal portion is parallel to the principal longitudinal axis.

Double Patenting

13. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

14. Claims 1 and 18 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 11 of copending Application No. 10/037,286(2002/0193771). This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The other references show other absorbent articles with finger receiving elements.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (703) 308-2617.

The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (703) 308-1957. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

K. M. Reichle
Karin M. Reichle
Primary Examiner
Art Unit 3761

KMR
November 11, 2003